

REMARKS

Reconsideration and allowance of all claims are requested.

The amendments to the Specification and claims 15, 16, and 20 simply address the informal issues (replace "dtex" with "decitex") raised in paragraphs 1 and 2, on page 2 of the office action. No new matter has been added by the amendments.

Claims 1 - 7, 9 - 11, and 13 - 22 are pending in the application.

Claims 1 - 4, 6, 7, 9-11, 13-16, 19 and 20 are patentable under 35 U.S.C. 102(b) over Browder, Jr. (U.S. 6,276,175).

Applicant relies on, without repeating here, all the arguments of record, presented towards the patentability of the claims.

The present claims define a clothing article and a method for manufacturing the clothing article for persons with hernia. The clothing article exerts compression on the user's lower part of the body and has a predefined size and shape as it is formed as a seamless tubular item with an anatomic fit producing compression of between 15 to 50 mmHg within a previously selected area of the clothing article. The article provides an approximately constant compression within a certain range of users' sizes and shapes and comprises elastic yarns, preferably elasthane, in a part between 15 and 60%, preferably between 30 and 50%, of the areas of the clothing article, which are to exert compression on the user's body.

Browder discloses a product, e.g. an undergarment which contains at least one area of control, which has a stitch pattern which increases the modulus of the tubular knit fabric. Browder describes a product of common type which is used to provide control/support of different body parts, e.g. hips, waists and under a women's breast.

The Examiner has propounded that Browder teaches all the claimed features. However, the 102(b) rejections on page 3-4 of the office action is silent on the claimed feature of the elastic yarns being between 15 to 60%, preferably between 30 and 50% of the previously selected areas that exert compression on the user's body. It appears that the Examiner is ignoring these claimed features only because Browder expressly teaches away from these features in column 3, lines 35-45, column 5, lines 25-34, and claims 14, 17. Browder expressly teaches that "... the 1x1 alternating tuck stitch pattern increases the modulus of the fabric, the fabric stretches less and controls more. Preferably, the modulus of the fabric is increased between 6% and about 10%, more preferably about 8% ... provides a desirable compromise between control and comfort."

It is apparent that Browder teaches away from the claimed invention and does not describe or teach or by inherency provide the claimed percentages of the compression areas. Thus, Browder is silent on the level for the compression and does not disclose the level of compression as claimed. For an invention to be anticipated, it must be demonstrated that each and every element of the claimed invention is present in the "four corners" of a single prior art, either expressly described therein or under the principle of inherency. *Lewmar Marine Inc. v. Barient Inc.*, 3 USPQ2d 1766, 1767-1768 (Fed. Cir. 1987) (emphasis added). The absence from a prior art reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986).

Therefore, independent Claims 1 and 9 are patentable over Browder at least because Browder does not teach compression of between 15 to 50 mmHg within a previously selected area of the clothing article, an approximately constant compression within a certain range of users' sizes and shapes, or elastic yarns used in a part between 15 and 60%, preferably between

30 and 50%, of the areas of the clothing article, which are to exert compression on the user's body. The Browder product is not capable of supplying a compression of between 15 to 50 mmHg or a constant compression within a range of user's sizes. Furthermore, Browder does not teach or suggest anywhere the use of 15 to 60% elastic yarns. Column 2, lines 25-29, which are cited to by the Examiner in this regard, say nothing about the percentage of elastic yarns. Indeed, it is not possible to determine the percentage of elastic yarns based on the information provided in Browder. The use of a high elastic yarn percentage in the areas of the clothing article that exerts compression on the user's body is essential and novel. To be anticipating, a prior art reference must disclose "each and every limitation of the claimed invention[,]... must be enabling[,] and must describe...[the] claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." *In re Paulsen*, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Claims 2 - 7, 10 - 11, and 13 depend from independent Claim 1 or 9 and add further patentable limitations. For at least the above reasons, the rejection of Claims 1 – 4, 6, 7, 9-11, 13-16, 19, and 20 under 35 U.S.C. 102(b) over Browder is improper and should be withdrawn.

Claims 17, 18 , 21, and 22 are patentable under 35 U.S.C. 103(a) over Browder, Jr. (U.S. 6,276,175).

As pointed out above, Browder does not describe, teach or suggest the claimed invention. Therefore, Browder cannot anticipate nor render obvious any of the claimed features.

The Examiner's rejection is neither based on rule of law nor on case law developed by the courts.

The Examiner states a novel basis for rejecting under 35 U.S.C. 103(a):

**"The USPTO office does not [sic] a laboratory to perform testing, and since the device of Browder, Jr. meets all of the structural recitations as claimed by applicant it is interpreted to perform in the same manner as the claimed invention ..."**

The Examiner is propounding new standards for the rejections under 35 U.S.C 103(a).

There is no basis for the Examiner's rejections based on "... "interpretation" .." because the "USPTO does not [have] a laboratory." That [the prior art] might incorporate elements which could be used in appellants' system does not render appellants' claims obvious when there is no suggestion of using these elements in substantially the same manner as appellants use them. *In re Donovan*, 184 USPQ 414, 421 (CCPA, 1975).

Citing *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984), the court pointed out, "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification". *In re Fritch*, 23 USPQ2d 1783, 1784 (Fed. Cir. 1992).

Applicant is unable to adequately rebut this rejection which is not based on the principles of law or case law because Applicant cannot quantify the metes and bounds of the Examiner's "interpretation" which is mere conjecture.

For purposes of appeal, Applicant respectfully requests the Examiner to clarify these rejections of claims 17, 18, 21, and 22, so that Applicant is given a fair opportunity for rebuttal prior to the Appeals process.

Claim 5 is patentable under 35 U.S.C. 103(a) over Browder, Jr. (U.S. 6,276,175) in view of Sinigagliesi (U.S. 2,736,036).

Browder does not teach nor suggest the claimed invention. Therefore, any further combination with secondary references will also teach away from the present claims. Thus, Claim 5 is patentable under 35 U.S.C. 103(a) over Browder in view of Sinigagliesi.

Claim 5 depends from independent patentable Claim 1 and claim 3, and shares its patentable features and adds further patentable limitations. Claim 5 adds that groin area in the panty brief there is provided an aperture so that the user can relieve himself without taking off the panty brief.

Browder relates to torso control in women and Sinigagliesi relates to elastic drawers, with modifications of fly openings for male users. Moreover, Sinigagliesi teaches that the tubular knitted fabric has elastic thread spirally interlaced in the girdle portion only. That contradicts with the teaching of Browder that requires entire areas of elastomeric yarn with a 1x1 alternating tuck stitch for increasing the modulus by 8%. The two teachings are mutually contradictory. Obviousness is tested by what the combined teachings of the references would have suggested to those of ordinary skill in the art. It cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Teachings of references can be combined only if there is some suggestion or incentive to do so. *In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

Therefore, one of ordinary skill in the art would be dissuaded from combining the two teachings, even if such combination is in hindsight reconstruction as has been done by the Examiner. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered

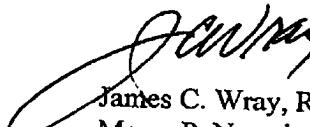
obvious." In re Fritch, 23 USPQ2d 1783, 1784 (Fed. Cir. 1992), quoting from In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Nothing in Browder, with or without Sinigagliesi, teaches a desirability of the modification as effected by the Examiner. Therefore claim 5 is also patentable over the cited references.

### CONCLUSION

Reconsideration and allowance of all claims are respectfully requested.

Respectfully,

  
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